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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,133	10/10/2001	J. Wallace Parce	100/00343	2344

21569 7590 09/27/2004  
CALIPER LIFE SCIENCES, INC.  
605 FAIRCHILD DRIVE  
MOUNTAIN VIEW, CA 94043-2234

EXAMINER
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CHIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/975,133	Applicant(s) PARCE ET AL.	
	Examiner Christopher L. Chin	Art Unit 1641	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 75-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 75-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 75-93 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide support for the reference stream recited in part (b) of claim 75. The sections of the instant specification cited by Applicants to support part (b) of claim 75 do not disclose a reference stream.

Furthermore, there is no disclosure of a "control compound" as asserted by Applicants in the table provided by Applicants comparing the claims of 6,171,865 to the instant specification.

The specification, as originally filed, does not provide support for the flow channel in part (c) of claim 75 having a dimension that allows laminar flow of more than one stream "adjacent to each other" and having "a length sufficient to allow analyte particles to diffuse from at least one stream selected from the group consisting of said sample stream and said reference stream into the indicator stream to form at least one detection area". The sections of the instant specification cited by Applicants do not disclose a flow channel that can support laminar flow of more than one stream wherein the streams are adjacent to each other and allows analyte particles to diffuse from at

least one stream selected from the group consisting of a sample stream and a reference stream into an indicator stream to form at least one detection area.

The specification, as originally filed, does not provide support for the charge coupled device camera, diode array detector, and electrochemical detector recited in claim 79. Page 17, lines 10-28, cited by Applicants refers to an optical detection system and exemplifies a photomultiplier tube to detect fluorescence. But there is no disclosure of a charge coupled device camera, diode array detector, or electrochemical detector.

The specification, as originally filed, does not provide support for the "at least one additional reference stream" recited in the claim 80. While the instant specification provides support for a source of at least one additional stream, there is no support for an additional reference stream.

The specification, as originally filed, does not provide support for the "reference streams" recited in claim 82. The sections cited by Applicants to support the limitations of claim 82 fail to provide any disclosure of reference streams.

The specification, as originally filed, does not provide support for the limitation in part (b) of claim 83 that recites "whereby the sample stream and said indicator stream flow in adjacent laminar flow in said channel". Applicants cite Figure 5 and page 26, lines 12-15, of the instant specification for support for the limitations in part (b) of claim 83. However, Figure 5 does not show two adjacent streams in laminar flow in a flow channel and lines 12-15 of page 26 of the instant specification do not disclose two adjacent streams in laminar flow in a flow channel.

The specification, as originally filed, does not provide support for “a reference stream comprising a constant concentration of 0 or greater of reference particles... whereby said reference stream flows in a laminar stream adjacent to said indicator stream” as recited in part (c) of claim 83. Applicants cite Figure 5 and pages 8, 25, and 26 of the instant specification for support for this limitation. Figure 5 does not show 2 adjacent streams in laminar flow. While page 8 of the instant specification mentions the use of a control, there is no disclosure of a reference stream, let alone a reference stream comprising a constant concentration of 0 or greater of reference particles.

The specification, as originally filed, does not provide support for the step recited in part (g) of claim 83 and 93. As discussed above, the instant specification does not provide support for two adjacent streams in laminar flow in a flow channel. Accordingly, the specification does not provide support for a step of diverting one of the adjacent streams from the flow channel as recited in step (g) of claim 83 and 93.

The specification, as originally filed, does not provide support for the reference streams recited in claims 84-90. While page 8 of the instant specification mentions the use of a control, there is no disclosure of a reference stream, let alone a reference stream (or control stream) with the specific limitations recited in claims 84-90.

The specification, as originally filed, does not provide support for absorbance and chemiluminescence as detectable properties as recited in claim 91. Applicants cite page 17, lines 12-21, of the instant specification to support the limitations of claim 91. Page 17, lines 12-21, of the instant specification only discloses colorimetric and

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fluorescence detection. There is no disclosure of absorbance and chemiluminescence detection.

### ***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin  
Primary Examiner  
Art Unit 1641

9/24/04